REMARKS

Applicants have received and carefully reviewed the Office Action mailed June 17, 2010. Claims 16-20 and 22-32 are pending and have been rejected. Applicants respectfully traverse all adverse assertions and rejections presented in the Office Action. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections under 35 U.S.C. §103

On page 2 of the Final Office Action, claims 16-20, 22, 24, 29-33 and 35-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Webster, Jr. (U.S. Patent No. 5,057,092) in view of Fish (U.S. Patent No. 5,006,291). Applicants respectfully traverse this rejection. As a preliminary matter, Applicants note that claims 33, 35, and 36 were previously canceled.

Turning to claim 16, which recites:

> 16. An intravascular catheter comprising an elongate shaft including an inner polymer layer defining a lumen of the elongate shaft, a reinforcement layer disposed about the inner polymer layer, and an outer polymer layer disposed about the reinforcement layer, the reinforcement layer comprising a tubular braid having a first helical member interwoven with a second helical member forming a plurality of crossover points and a plurality of axial members disposed between the first helical member and the second helical member at each of the plurality of crossover points, wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer.

Nowhere do Webster, Jr. and Fish, taken either alone or in combination, appear to disclose many elements of claim 16, including for example, "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer".

On page 2 and with regard to Webster, Jr., the Office Action states "As seen in Figs. 2 or 5, the plurality of axial members 28 are attached at the distal end of inner layer 22 and the proximal end of inner layer 22 (not shown); the axial members 28 are free and movable in between the first and second helical members 24 and 26. Therefore, the plurality of axial members 28 are not fixed to the inner polymer layer and the outer layer such that the plurality of

axial members are moveable relative to the inner polymer layer and the outer polymer layer". This is not understood. Nowhere does Webster, Jr. appear to teach "the axial members 28 are free and movable in between the first and second helical members 24 and 26", as suggested by the Office Action. Instead, column 3, lines 7-11 of Webster, Jr. appear to state:

> The reinforcing mesh is made by a conventional braiding process. In such a process, the braid members are interwoven, under tension, around the inner wall. The outer wall is then applied by dipping, spraying, extrusion or any other suitable process.

Applicants respectfully submit that applying the outer wall by dipping or spraying would appear to fix the outer wall to the braid members and the braid members would not appear to be moveable relative to the outer wall. As such, Webster, Jr. cannot be considered as teaching "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer", as recited in claim 16. Furthermore, nowhere does the Office Action cite any portion of Webster, Jr. as providing support for "the axial members 28 are free and movable in between the first and second helical members 24 and 26", as asserted in the Office Action. Applicants respectfully request that if this rejection is to be maintained, the next communication specifically point out where in the cited references support for the assertion of "the axial members 28 are free and movable in between the first and second helical members 24 and 26" can be found.

Further, if the Office Action is somehow considering "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer" to be inherent in Webster, Jr., Applicants submit that there is no basis for such an interpretation. MPEP § 2112(IV) states:

> The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **<u>necessarily present</u>** in the thing described in the reference, and that it would be

> so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)...
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> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

(Emphasis added). Appellants respectfully submit "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer" is clearly not necessarily present in Webster, Jr. Instead, as discussed above, the longitudinal warp members of Webster, Jr. would appear to be fixed relative to the outer polymer layer. As such, nowhere does Webster, Jr. appear to disclose "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer", as recited in claim 16.

Furthermore, nowhere does Fish appear to disclose "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer". The Office Action appears to quote a portion of the present specification, namely page 13, lines 6-13, and then states: "Similarly, Fish suggests the arrangement of first, second helical members and the axial members are same as the claimed invention. Therefore, the pluralities of axial members are not fixed and movable to maintain some amount of flexibility". Applicants respectfully disagree. Applicants respectfully submit that Fish does not disclose the same arrangement of axial members as claim 16 or, more specifically, "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer". Instead, column 5, lines 35-41 of Fish states:

> It is one of the important aspects of the finished product according to this invention that all of the reinforcement strands are adequately wet with the liquid matrix material so that,

> when cured, all parts of the surfaces of all of the strands will be directly locked to the plastic matrix and, thus, to each other to result in the strongest reinforced tubing for a given weight. (emphasis added)

As can be seen, Fish appears to disclose the strands being locked to the plastic matrix. As such, the strands of Fish clearly cannot be considered as being not fixed to the inner polymer layer and the outer polymer layer such that the strands are moveable relative to the inner polymer layer and the outer polymer layer. As such, Fish does not appear to disclose "wherein the plurality of axial members are not fixed to the inner polymer layer and the outer polymer layer such that the plurality of axial members are moveable relative to the inner polymer layer and the outer polymer layer", as recited in claim 16. For at least these reasons, claim 16 is believed to be patentable over Webster, Jr. in view of Fish. For similar reasons and others, claims 17-20, 22, and 24, which depend from claim 16 and include additional distinguishing features, are also believed to be patentable over Webster, Jr. in view of Fish. Withdrawal of the rejection is respectfully requested.

Turning to claim 29, which recites:

> 29. A method of making a portion of a shaft of an intravascular catheter, the method comprising the steps of:
> providing a carrier including an elongate tube having an inner polymer layer disposed thereon;
> braiding a first helical member, a second helical member, and a plurality of axial members about the carrier forming a plurality of crossover points, wherein the plurality of axial members are disposed between the first and second helical members at each of the plurality of crossover points such that the plurality of axial members are not fixed to the inner polymer layer; and
> disposing an outer polymer layer over the reinforcement layer, wherein the outer polymer layer is not fixed to the plurality of axial member.

Similar to as discussed above with reference to claim 16, nowhere do Webster, Jr. and Fish, taken either alone or in combination, appear to disclose many elements of claim 29, including for example, "braiding a first helical member, a second helical member, and a plurality of axial members about the carrier forming a plurality of crossover points, wherein the plurality of axial members are disposed between the first and second helical members at each of the plurality of crossover points such that the plurality of axial members are not fixed to the inner polymer layer" or "disposing an outer polymer layer over the reinforcement layer, wherein the outer

polymer layer is not fixed to the plurality of axial member". For at least reasons similar to those discussed above with reference to claim 16, claim 29 is believed to be patentable over Webster, Jr. in view of Fish. For similar reasons and others, claims 30-32, which depend from claim 29 and include additional distinguishing features, are also believed to be patentable over Webster, Jr. in view of Fish. Withdrawal of the rejection is respectfully requested.

Double Patenting Rejections

On page 5 of the Office Action, claims 16-32 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,709,429. Also on page 5 of the Office Action, claims 16 and 22-30 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6-9, 11 and 13-28 of U.S. Patent No. 6,942,654. While Applicants respectfully disagree with these rejections, Applicants will consider filing a Terminal Disclaimer when the claims are otherwise indicated as being allowable.

Conclusion

Reconsideration and further examination of the rejections are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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